

REMARKS/ARGUMENTS

Claims 31 – 61 are pending with claims 47 – 60 being withdrawn from consideration.

The specification has been amended. Claims 34 and 45 have been amended. A new claim 61 depending from claim 31 has been added.

In the Office Action, it is noted that restriction is required for the reason that the present application contains claims 31 – 46, drawn to a method of coating an optically readable data carrier (Group I claims), claims 47 – 56, drawn to an apparatus for coating an optically readable data carrier (Group II claims), and claims 57 – 60, drawn to an optically readable data carrier (Group III claims) and it is further noted that Applicants have elected with traverse claims 31 – 46 (Group I claims) for prosecution of the merits. Also, in the Office Action, it is noted that the application does not include an abstract of the disclosure. Additionally, in the Office Action, claims 33 and 45 and the specification are objected to. Furthermore, in the Office Action, claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Moreover, in the Office Action, claims 31, 33, 36, 40, and 42 - 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeda (EP 485366). Additionally, in the Office Action, claims 31, 33, 36, 40, and 42 - 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (EP 485366) in view of U.S. Patent 4,961,979 to Iida et al. Furthermore, in the Office Action, claims 32, 34 – 35, and 38 - 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (EP 485366) in view of U.S. Patent 4,961,979 to Iida et al as applied to claim 31 and further in view of U.S. Patent 6,200,402 to Amo. Still further, in the Office Action,

claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (EP 485366) in view of U.S. Patent 4,961,979 to Iida et al as applied to claim 31 and further in view of U.S. Patent 6,200,402 to Amo and U.S. Patent 5,891,290 to Deurer et al. Additionally, in the Office Action, claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (EP 485366), U.S. Patent 4,961,979 to Iida et al, and U.S. Patent 6,200,402 to Amo as applied to claim 43 and further in view of Ozawa et al (JP 6-293322).

Turning first to the restriction requirement, it is asserted in the Office Action that claims 31 – 46, drawn to a method of coating an optically readable data carrier (Group I claims) and claims 47 – 56, drawn to an apparatus for coating an optically readable data carrier (Group II claims) have no common technical feature. However, Applicants submit that both the Group I claims and the Group II claims have the common technical feature of coating an optically readable data carrier. Additionally, it is asserted in the Office Action that claims 47 – 56, drawn to an apparatus for coating an optically readable data carrier (Group II claims) and claims 57 – 60, drawn to an optically readable data carrier (Group III claims) share a special technical feature relating to a transparent adhesive film and a covering film that covers a data-carrying surface but that this feature is known from the prior art as evidenced, for example, by Takeda (EP 485366). However, Applicants submit, as will be set forth in more detail below, that the special technical feature relating to a transparent adhesive film shared by the Group II claims and the Group III claims is, in fact, not taught or disclosed by Takeda (EP 485366) or any prior art. Therefore, Applicants traverse the restriction requirement and respectfully request that the

Group II (claims 47 – 56) and the Group III claims (claims 57 – 60) be considered on the merits as well.

Turning next to the objections to the specification, Applicants have submitted an Abstract of the Disclosure herewith and have added the term "(polycarbonate)" to Page 2. With respect to the objection to page 13, line 16, Applicants submits that no amendment is necessary. Accordingly, it is submitted that the specification is now non-objectionable.

With respect to the objections to claims 33 and 45 and the rejection of claim 34 under 35 U.S.C Section 112, second paragraph, Applicants have amended claim 45 in accordance with the Examiner's suggestions and have amended the specification to add the term "(polycarbonate)". Also, Applicants have amended claim 34 to clarify that claim. Accordingly, it is respectfully requested that the objections to claims 33 and 45 and the rejection of claim 34 under 35 U.S.C Section 112, second paragraph, be withdrawn.

Looking now at the substantive rejection of the claims, Applicants submit that claim 31, and claims 32 – 46 and 61 ultimately depending therefrom, are neither anticipated, nor rendered obvious, by the cited references, either individually or in combination with one another.

Claim 31 of the present application recites a method of coating an optically readable data carrier, including the steps of applying a transparent adhesive film to a data carrier surface that is to be protected and subsequently applying a covering film to the adhesive film.

Takeda (EP 485366) discloses securing a protective film 5 to an optical higher reflection layer 4b of a card substrate via an adhesive.

Takeda (EP 485366) fails to disclose or suggest the method of coating an optically readable data carrier as recited in claim 1 of the present application. For example, Takeda (EP 485366) does not disclose or suggest the step of applying a transparent adhesive film to a data carrier surface that is to be protected. To the extent that Takeda (EP 485366) discloses that the protective film 5 is adhered to the optical higher reflection layer 4b, Takeda (EP 485366) does not indicate or even hint that the adhesive is a preformed layer. In fact, Takeda (EP 485366) discloses, on Page 10 thereof, lines 8 – 9, that the prepared pattern film and card substrate of Example 2 of Takeda (EP 485366) were stacked via an epoxy resin (a 10:4 mixture of Pellnox MG 150 and Pellicure HY 306), which is a teaching to one of skill in the art to deploy a fluid adhesive (such as the epoxy resin). In contrast, as noted above, claim 31 of the present application recites the step of applying a transparent adhesive film. The use of an adhesive in the form of a (transparent) film as proposed by the present invention has advantages over the use of a fluid adhesive such as an epoxy such as disclosed in Takeda (EP 485366) in that fluid adhesives are typically applied onto a substrate such as a data carrier by a centrifuging process that disadvantageously results in flung-off residual fluid adhesive, which must be removed in an expensive and complicated manner, whereas, in contrast, an adhesive in the form of a film brings with it no such residual clean up requirements.

Likewise, the method recited in claim 31 of the present application is not anticipated by, nor rendered obvious by, the other prior art of record. For example, the other prior art of record also fails to disclose or suggest the advantage of an adhesive in the form of a (transparent) film in lieu of a fluid adhesive.

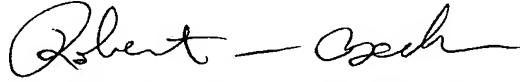
It is therefore submitted that claim 31, and claims 32 – 46 depending therefrom, are patentable over the cited references and the withdrawal of the rejections of these claims under 35 U.S.C. 102 and 103 is respectfully requested.

Applicants also submit that claim 61 patentably defines over the prior art of record. Claim 61 recites that, with respect to the method set forth in claim 31 of the present application, the step of applying a transparent adhesive film to a data carrier surface that is to be protected includes positioning a preformed layer of transparent adhesive film relative to the data carrier surface that is to be protected and, after the step of positioning a preformed layer of transparent adhesive film relative to the data carrier surface, applying a force relative to at least one of the preformed layer of transparent adhesive film and the data carrier surface to cause compression in the direction toward the data carrier surface of at least that much of the preformed layer of transparent adhesive film that has already been positioned relative to the data carrier surface. Also, new dependent claim 61 recites that, in the method of the present invention as set forth in claim 31, no additional transparent adhesive material beyond the preformed layer of transparent adhesive film is applied to the data carrier surface before the step of subsequently applying a covering film to the adhesive film. As noted, none of the prior art of record teaches or discloses applying an adhesive film on a data carrier to which a covering film is then adhered, whereupon it is clear that the steps recited in new claim 61 further distinguish over the prior art of record in that claim 61 recites further details of the step of applying the transparent adhesive film.

In light of the foregoing arguments in support of patentability, Applicants respectfully submit that this application now stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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